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**MAILED**

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**OFFICE OF PETITIONS**

In re Application of :  
Pitell et al. :  
Application No. 09/663,171 :  
Patent No. 6,352,121 : DECISION ON PETITION  
Filed: September 15, 2000 : PURSUANT TO 37 C.F.R.  
Issue Date: March 5, 2002 : § 1.378(B)  
Attorney Docket No. 99-1870 :  
Title: VEHICLE FIRE :  
EXTINGUISHER SYSTEM :  
:

This is a decision on the petition filed on January 24, 2011, pursuant to 37 C.F.R. § 1.378(b) to reinstate the above-identified patent.

This petition pursuant to 37 C.F.R. § 1.378(b) is **DISMISSED**.

**Background**

The patent issued on March 5, 2002. The grace period for paying the 3½-year maintenance fee provided in 37 C.F.R. § 1.362(e) expired at midnight on March 5, 2006, with no payment received. Accordingly, the patent expired on March 5, 2006 at midnight.

Any petition to accept an unavoidably delayed payment of a maintenance fee filed under 37 C.F.R. § 1.378(b) must include:

- (1) the required maintenance fee set forth in 37 C.F.R. § 1.20 (e) through (g);
- (2) the surcharge set forth in 37 C.F.R. § 1.20(i)(1), and;
- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be

paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent - the showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

Both the surcharge associated with a petition to accept the late payment of a maintenance fee as unavoidable and the 3½ and 7½-year maintenance fees were submitted on January 24, 2011, along with a one-paragraph statement of facts. Petitioner has also included an overpayment in the amount of \$70. This \$70 will be refunded via the issuance of a Treasury Check in due course.

The first and second requirements of Rule 1.378(b) have been satisfied. The third requirement of Rule 1.378(b) has not been satisfied, as will be discussed below.

#### The standard

35 U.S.C. § 41(c)(1) states, *in pertinent part*:

The Director may accept the payment of any maintenance fee... after the six-month grace period if the delay<sup>1</sup> is shown to the satisfaction of the Director to have been unavoidable.

37 C.F.R. § 1.378(b)(3) is at issue in this case. Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 37 C.F.R. § 1.137(a). This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business.<sup>2</sup>

<sup>1</sup> This delay includes the entire period between the due date for the fee and the filing of a grantable petition pursuant to 37 C.F.R. § 1.378(b).

<sup>2</sup> In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account." Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable."<sup>3</sup>

The burden of showing the cause of the delay is on the person seeking to revive the application.<sup>4</sup>

#### **Application of the standard to the current facts and circumstances**

Petitioner has explained that on June 1, 2010, he learned that this patent has expired for failure to submit the 3-½ year maintenance fee, and has alleged that he "paid the patent fees and the maintenance fees in advance," and that the "Invention Submission Corporation's patent attorney" failed to tell him that the patent was expired when he paid said fees.

The period for paying the 3½-year maintenance fee without the surcharge extended from March 5, 2005 to September 4, 2005 and for paying with the surcharge from September 5, 2005 to March 5, 2006. Thus, the delay in paying the 7½-year maintenance fee extended from March 5, 2006 at midnight to the filing of this petition on January 24, 2011.

Patentee has provided an indication of the manner in which he became aware of the expiration of the patent.

The record does not contain a showing that the delay was unavoidable, as will now be pointed out.

First, the record does not contain an enumeration of the steps taken to ensure timely payment of the maintenance fee. An adequate showing that the delay in payment of the maintenance fees at issue was "unavoidable" within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Where the record fails to disclose that the patentee took reasonable steps to ensure timely payment of the maintenance fees, 35 U.S.C. § 41(c) and 37 C.F.R. § 1.378(b)(3)

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<sup>3</sup> *Haines v. Quigg*, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

<sup>4</sup> *Id.*

preclude acceptance of the delayed payment of the maintenance fee under 37 CFR § 1.378(b).

The record is not clear on why these maintenance fees were not submitted to the Office. Petitioner has alleged that he paid the maintenance fees in advance. Petitioner has indicated:

"I contacted the U.S. Patent and Trademark Office and found out that my patent was in delinquent status due to my Maintenance Fees at all, which due to Invention Submission Corporation's patent attorney neglected to inform me of that fact when I paid the patent fees and the maintenance fees in advance."

The meaning of this sentence is unclear. What amount did he pay, when was this payment made, and to whom was this money tendered? Did Petitioner tender money to the Invention Submission Corporation, with the understanding that the Invention Submission Corporation would submit this money to the United States Patent Office in order to pay the maintenance fees? If so, which maintenance fees were the Invention Submission Corporation supposed to transmit to the Office, and when? Petitioner would be well advised to provide documentation which would substantiate any assertion that the Invention Submission Corporation was obligated to submit the 3½ and 7½ year maintenance fees on his behalf.

Moreover, Petitioner will note that a patent holder's reliance upon an attorney does not provide him with an absolute defense, but rather shifts the focus to whether the attorney acted reasonably and prudently.<sup>5</sup> It is well established that a patent holder is bound by any errors that may have been committed by his attorney.<sup>6</sup> Petitioner will need to establish that any alleged failure of the Invention Submission Corporation could not have been avoided with the exercise of due care. Whether an action by an attorney constituted a breach of the fiduciary duty of care is of no moment to the issue of whether the entire delay was unavoidable.<sup>7</sup>

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<sup>5</sup> California Medical Products v. Technol Med. Prod., 921 F. Supp. 1219, 1259 (D. Del. 1995).

<sup>6</sup> Smith v. Diamond, 209 U.S.P.Q. 1091, 1093 (D.D.C. 1981)(citing Link v. Wabash Railroad Co., 370 U.S. 626, 8 L. Ed. 2d 734 (1962).

<sup>7</sup> See Haines v. Quigg, 5 USPQ2d 1130 (N.D. Ind. 1987)(the court, in affirming an Office decision denying revival of an application on the basis of unavoidable delay, stated: "If the attorney somehow breached his duty of care to plaintiff, then plaintiff may have certain other remedies available to him against his attorney. He cannot, however, ask the court to overlook [attorney's] action or inaction with regard to the patent application.")

Second, the record does not contain a description of the steps taken to file the petition promptly. Petitioner has indicated that he learned of the expiration of this patent on June 1, 2010 when he contacted the United States Patent and Trademark Office. Why was this petition not filed until more than seven months had passed?

### Conclusion

Any request for reconsideration of this decision must be filed within **TWO MONTHS** of the mailing date of this decision. Any such petition for reconsideration must be accompanied by the \$400 petition fee set forth in 37 C.F.R. § 1.17(h). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Accordingly, on request for reconsideration, it is extremely important that Petitioner supply any and all relevant information and documentation in order to meet his burden of showing unavoidable delay. This includes statements by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Petitioner must provide documentation and address the deficiencies noted above. If on request for reconsideration, the delayed payment of the maintenance fees is not accepted, then the maintenance fees are subject to refund following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed.

The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.378(e)". This is not a final agency action within the meaning of 5 U.S.C § 704.

Any response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail,<sup>8</sup> hand-delivery,<sup>9</sup> or facsimile.<sup>10</sup> Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.<sup>11</sup>

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone

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<sup>8</sup> Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

<sup>9</sup> Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

<sup>10</sup> (571) 273-8300 - please note this is a central facsimile number.

<sup>11</sup> <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

inquiries regarding this decision should be directed to the undersigned at (571) 272-3225. Inquiries pertaining to the submission of maintenance fees should be directed to the Maintenance Fee branch at 571-272-6500.

It is noted that the address listed on the petition differs from the address of record. The application file does not indicate a change of correspondence address has been filed in this case, although the address given on the petition differs from the address of record. If Petitioner desires to receive future correspondence regarding this patent, the change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to the address which appears on the petition. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence related to this patent unless Change of Correspondence Address, Patent Form (PTO/SB/123) is submitted for the above-identified patent. For Petitioner's convenience, a blank Change of Correspondence Address, Patent Form (PTO/SB/123), may be found at <http://www.uspto.gov/web/forms/sb0123.pdf>.

If appropriate, a change of fee address (form PTO/SB/47) and a request for customer number (form PTO/SB/125) should be filed in accordance with Manual of Patent Examining Procedure, section 2540.

A blank fee address form may be found at <http://www.uspto.gov/web/forms/sb0047.pdf>.

/Paul Shanoski/  
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